



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,286	01/25/2000	Rose K. Davis	016295.0857	8352
23640	7590	06/02/2006	EXAMINER BORLINGHAUS, JASON M	
BAKER BOTTS, LLP 910 LOUISIANA HOUSTON, TX 77002-4995			ART UNIT 3628	
PAPER NUMBER				

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/491,286	Applicant(s) DAVIS ET AL.	
	Examiner Jason M. Borlinghaus	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 44 - 57 are objected to because of the following informalities: lack of antecedent basis and/or inconsistent terminology. Although, examiner assumes that varying claim language references the same claim limitation, claims language should utilize consistent terminology to ensure clarity.

For example, Claim 44 recites "storing configuration data as old system configuration" while later referencing the configuration data as "old hardware configuration data." Claim 44 also recites submitting "a configuration request" concerning an old computer system, and then submitting a "hardware inquiry" concerning a new computer system.

Claim 53 claims obtaining "old configuration data" concerning an old computer system, while Claims 54 – 57 claim "old hardware description"

Dependent claims are objected to based upon dependency.

Please review all claims and correct where appropriate.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3628

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

To ensure clarity and clear understanding of examiner's rationale for application of cited prior art, terminology contained within parentheses indicates quoted language contained within said cited prior art reference while unquoted language contained within parentheses indicates the general concept as conveyed by said cited prior art reference. Such parenthetical terminology is to be interpreted as "reading on" or being "mapped to" the claim language prior to such parenthetical inclusions.

Claims 44 - 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rathbone (Rathbone, A. *Upgrading & Fixing PCs For Dummies: 4th Edition*. Foster City, CA, IDG Books Worldwide Inc, 1998. pp. 12 – 16, 23, 26, 58 – 62, 75 – 76, 88 – 89, 163 - 164, 184 – 185, 320 - 322 and 326) in view of Jacobs (Jacobs, April. *More Businesses Buying PCs Online*. *Computerworld*. Framingham. vol. 32, iss. 34. August 24, 1998. pp. 45 – 46) and Russell (Russell, Deborah & Gangemi Sr, G.T. *Computer Security Basics*. O'Reilly & Associates. 1991. pp. 146 – 147).

Regarding Claims 44, 45 and 47, Rathbone discloses a method comprising:

- executing configuration utility software (“Device Manager”) on the old (current) computer system. (see pp. 75 - 76);
- receiving old (original) configuration data for the old (original) computer system. (see pp. 26 and 75 – 76, such as through retained “old boxes, manuals, warranties, and receipts” or through “Device Manager”);
- storing the old (current) configuration data as an old (current) system configuration data. (see pp. 23, 26 and 88 – 89, such as storing the configuration as by “writ[ing] down the names of all the other gizmos in your computer”, “hang[ing] onto your old boxes, manuals, warranties, and receipts” and “writing down part numbers.”); and
- selecting at least one component of the old (current) computer system for reuse in the new system. (see p. 163, *such as* “dissect[ing] that old 486 for parts... Grab the monitor and then attach it and the video card in your new computer.”).

Rathbone does not *explicitly* teach a method comprising:

- comparing the new hardware configuration data and the old (current) hardware configuration data; and

Art Unit: 3628

- determining a compatible component list indicating which components of the old (current) computer system may be reused in the new computer system.

Comparing configuration data between two systems to access the reusability and/or compatibility of components between one or more systems is old and well-known with the art of computer system design and computer maintenance, as evidenced by Rathbone which states, "Still, dissect that old 486 for its parts: Yank out the old video card, or buy a new old if the old card isn't PCI compatible." (see p. 163, *Will Replacing My Old CPU With A Hot, New CPU Speed It Up ?*). Rathbone further discusses component compatibility issues in general, such as with expansion cards, memory chips and hard drives, as a consideration whenever components are replaced and/or added to a computer system. (see pp. 58 – 62, 184 – 185 and 321). Such statements imply that the user must assess the reusability and compatibility of components when reusing said components such as when making the determination whether an old component would even be compatible with the new computer system.

In considering the disclosure of Rathbone, it is pertinent to point out not only specific teachings of Rathbone but also the reasonable inferences which one skilled in the art which one skilled in the art would logically draw therefrom. *In re Shepard*, 138 USPQ 148 (CCPA 1963). Additionally, every patent application and reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed, in order that it be 35 USC 112

Art Unit: 3628

“enabling,” and to satisfy requirements of reference under 35 USC 102. *In re Bode, Nolan, Baker, Mathias and Pfaender*, 193 USPQ 12 (CCPA 1977).

It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made that the method utilized by Rathbone would have also utilized the ability to compare configuration data and to determine a compatible component list of components which may be reused, as is implied by Rathbone, allowing the user to determine which parts may be reused in a new computer system.

Rathbone does not teach that the method is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Rathbone does not teach the underlined limitations - a method comprising:

- accessing a first manufacturer's database, wherein accessing includes logging onto the storefront database from a first computer network;
- requesting information from an old computer system using a configuration request;
- receiving old configuration data for the old computer system from the first manufacturer's database;

Art Unit: 3628

- accessing a second manufacturer's new computer hardware catalog stored in a storefront database using a second computer network;
- transmitting a new hardware inquiry to the storefront database;
- receiving new hardware configuration data corresponding to a new computer system from the second manufacturer;
- the first network being the same as the second computer network;
- highlighting any components of the old computer system identified by the configuration utility software as differing from the old system configuration data; and
- altering the old system configuration data to reflect any different components identified by the configuration utility software.

Jacobs discloses a method comprising:

- accessing a first/second manufacturer's (Dell/Gateway/Compaq...) database/hardware catalog ("website"), wherein accessing includes logging onto the storefront database ("website") from a first/second computer network ("Internet"). (see pp. 45 – 46, including pictures);
- requesting/transmitting information about an old/new computer system using a configuration request/hardware inquiry (product/model search). (see pp. 45 – 46, including pictures);
- receiving configuration data (specs/configuration) for the old/new computer system from the first/second manufacturer's database. (see pp. 45 – 46, including pictures); and

Art Unit: 3628

- the first network ("Internet") being the same as the second computer network ("Internet").

Searching a manufacturer's database ("website") via configuration requests/hardware inquiries (product/model search) and receiving configuration data about the requested computer system is old and well known in the art of Internet sales and computer sales, as evidenced by Jacobs (see pictures).

In considering the disclosure of Jacobs, it is pertinent to point out not only specific teachings of Jacobs but also the reasonable inferences which one skilled in the art which one skilled in the art would logically draw therefrom. *In re Shepard*, 138 USPQ 148 (CCPA 1963). Additionally, every patent application and reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed, in order that it be 35 USC 112 "enabling," and to satisfy requirements of reference under 35 USC 102. *In re Bode, Nolan, Baker, Mathias and Pfaender*, 193 USPQ 12 (CCPA 1977).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone by incorporating the ability to request configuration data from the manufacturer's database, as disclosed by Jacobs, to provide an additional avenue through which to secure configuration data of the old computer systems, supplementing other manufacturer documentation such as "sales receipts" and "old manuals," as disclosed by Rathbone (see pp. 26 and 75).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone and Jacobs by incorporating the

Art Unit: 3628

ability to request configuration data from the manufacturer's database, as disclosed by Jacobs, to obtain configuration data of a new computer system, allowing the user to anticipate which components may or may not be reused, allowing the user to plan a purchase of a new computer system.

Configuration management, such as recording computer system configuration data and updating such configuration data to reflect any different components installed, is old and well known in the art of information technology, as evidenced Russell (see pp. 146 – 147). It would have been obvious to one of ordinary skill at the time the invention was made to have modified Rathbone and Jacobs with standard configuration management techniques, as disclosed by Russell, allowing for the maintenance of records of configuration components available to the user for reuse, replacement and/or possible sale.

Russell does not utilize the term “highlighting” in regards to configuration management. However, Russell does state that, “the identifier [for a configuration component] consists of a number of fields that describe, in some fashion, the item it identifies. For example, one field might represent the system or software version, and another the item itself.” (see p. 147). Such supplemental fields, as disclosed by Russell, could be utilized to “highlight” any components that differ from the original as Russell states that “components [are] to be tracked individually” and such fields can be utilized to represent the system “version”. (see p.147)

Regarding Claim 46, Rathbone does not teach the underlined limitations

- a method further comprising:

- the first manufacturer being the same as the second manufacturer.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to have modified Rathbone, Jacobs and Russell by incorporating the fact that the first manufacturer of the old computer system and the second manufacturer of the new computer system could have been the same manufacturer. Jacobs provides a list of possible vendors and their comparative portions of the marketplace (see pp. 45 – 46). Considering the limited number of popular manufacturers, as indicated above, and brand loyalty among consumers, it would have been possible for consumers to purchase their new computer system from the same manufacturer as their old computer system.

Claims 48 – 49, 51, 58 – 60 and 62 - 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rathbone, Jacobs and Russell, as with Claim 44 and 45 above, and in further view of Kaplan (Kaplan, K. *Integrating Old PCs Back Into Society*. *Los Angeles Times*. December 20, 1995. p.4).

Rathbone discloses a method further comprising:

- considering utilizing new components in a old computer system.
(see pp. 163 and 320);
- considering utilizing old components in a new computer system.
(see pp. 163 and 320);
- considering disposing of old components (see p. 320);
- considering selling old components. (see p. 322, such as through a “trade in” with “a local chip merchant”); and

Art Unit: 3628

- considering financial implications of replacing components and/or purchasing new computer system. (see pp. 12 – 16).

Rathbone does not teach the underlined limitations - a method further comprising:

- determining the street values of the old computer system with and without at least one reusable component; and
- determining whether to reuse a component of the old computer system in the new computer system based on the street values and;
- obtaining price estimates for the new computer system with and without the component selected for reuse.

Jacobs discloses a method further comprising:

- obtaining price estimates (price quotes) for the new computer system with and without the component selected for reuse (based upon configuration). (see pp. 45 – 46, including pictures).

Kaplan discloses a method further comprising:

- determining the street values (price quote) of the old computer system with and without at least one reusable component (“[d]epending upon the configuration”). (“...RTI will pay for the machines. Depending on the configuration, condition and manufacturer of a computer, RTI will pay \$100 to \$200 for a used 286 PC....”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs and Russell by incorporating the ability to obtain price estimates for a new computer system with and without the component selected for reuse, as disclosed by Jacobs, to assist in financial analysis of whether to reuse components versus buying entire new computer system, as disclosed by Rathbone, by determining whether the reusable component has more value as a reusable component or as something to be sold with the old computer system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs and Russell by incorporating the ability to determine the street values of the old computer with and without reusable components, as was disclosed by Kaplan, to assist in financial analysis of whether to reuse components versus buying entire new computer system, as disclosed by Rathbone, by determining whether the reusable component has more value as a reusable component or as something to be sold with the old computer system.

Cost benefit analysis, such as weighing alternative courses of action, is old and well known in the art of decision-making and financial analysis. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, Russell and Kaplan by incorporating a cost benefit analysis of the various financial implications of alternative courses of action, as disclosed by Rathbone and Kaplan, allowing the user to select the

Art Unit: 3628

optimal course of action available to him, as defined by financial implications of said course of action.

Regarding Claim 58, Claim 58 recites similar limitations to Claims 44, 45, 48, 49 and 51, in combination, except:

- computing transaction amounts with and without reuse of the reusable component; and
- selecting the lowest transaction amount.

Rathbone discloses a method comprising:

- considering utilizing new components in a old computer system.
(see pp. 163 and 320);
- considering utilizing old components in a new computer system.
(see pp. 163 and 320);
- considering disposing of old components (see p. 320);
- considering selling old components. (see p. 322, such as through a “trade in” with “a local chip merchant”); and
- considering financial implications of replacing components and/or purchasing new computer system. (see pp. 12 – 16).

Jacobs discloses a method further comprising:

- computing transaction costs (price quotes) with and without reuse of the reusable component (based upon configuration). (see pp. 45 – 46, including pictures).

Cost benefit analysis, such as weighing alternative courses of action, is old and well known in the art of decision-making and financial analysis. It would

Art Unit: 3628

have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, Russell and Kaplan by incorporating a cost benefit analysis of the various financial implications of alternative courses of action, as disclosed by Rathbone, Kaplan and Jacobs, allowing the user to select the optimal course of action available to him, as defined by financial implications of said course of action.

Regarding Claim 59 - 60, Rathbone discloses a method further comprising:

- considering utilizing new components in a old computer system.
(see pp. 163 and 320);
- considering utilizing old components in a new computer system.
(see pp. 163 and 320);
- considering disposing of old components (see p. 320);
- considering selling old components. (see p. 322, such as through a “trade in” with “a local chip merchant”); and
- considering financial implications of replacing components and/or purchasing new computer system. (see pp. 12 – 16).

Rathbone does not teach underlined limitation - a method further comprising:

- modifying the new configuration data to omit/indicate at least one reusable component selected based on the lowest transaction amount and ordering a new computer system corresponding to the new configuration data.

Art Unit: 3628

Jacobs discloses a method further comprising:

- modifying new configuration data to omit/indicate at least one component (based upon configuration) and ordering a new computer system corresponding to the new configuration data (based upon configuration). (see pp. 45 – 46, including pictures).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, Russell and Kaplan by incorporating the ability to modify and order a new computer system configuration, as disclosed by Jacobs, to accommodate the possible reuse of components from the old computer system, as disclosed by Rathbone, to reduce the cost of a new computer system.

Cost benefit analysis, such as weighing alternative courses of action, is old and well known in the art of decision-making and financial analysis. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, Russell and Kaplan by incorporating a cost benefit analysis of the various financial implications of alternative courses of action, as disclosed by Rathbone, Kaplan and Jacobs, allowing the user to select the optimal course of action available to him, as defined by financial implications of said course of action.

Regarding Claims 62 – 63, Claims 62 – 63 recite similar limitations to Claim 44 and are therefore rejected using the same art and rationale as applied in the rejection of Claim 44.

Art Unit: 3628

Claims 50 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rathbone, Jacobs, Russell and Kaplan, as with Claims 48 and 58 above, and in further view of Barzilai (US Patent 6,012,045).

Rathbone discloses a method further comprising:

- disposing of an old system configuration minus at least one component to be reused in the new computer system. (see p. 320);
- considering selling old components. (see p. 322, such as through a “trade in” with “a local chip merchant”); and
- considering financial implications of replacing components and/or purchasing new computer system. (see pp. 12 – 16).

Rathbone does not teach the underlined limitations – a method comprising:

- transmitting a hardware description to an online auction site comprising the old system configuration minus at least one component to be reused in the new computer system; and
- modifying the old configuration data to omit at least one reusable component selected based on the lowest transaction amount and transmitting the old configuration data to an online auction system.

Barzilai discloses a method further comprising:

- transmitting a hardware description/configuration data to an online auction site. (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, Russell and Kaplan by

Art Unit: 3628

incorporating the ability to dispose of the old computer system minus the reusable component, as disclosed by Rathbone, via an online auction, as disclosed by Barzilai, would require the transmission of an accurate hardware description to the online auction site, as disclosed by Barzilai, to allow the user to recover some financial benefit from the disposing of the old computer system.

Cost benefit analysis, such as weighing alternative courses of action, is old and well known in the art of decision-making and financial analysis. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs, Russell, Kaplan and Barzilai by incorporating a cost benefit analysis of the various financial implications of alternative courses of action, as disclosed by Rathbone, Kaplan and Jacobs, allowing the user to select the optimal course of action available to him, as defined by financial implications of said course of action.

Claims 52 - 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rathbone, Jacobs and Russell, as with Claim 44 above, and in further view of Anonymous (Anonymous. *Are You Y2K Complaint. The API Account*. Baltimore: Spring 1999, vol. 26, issue 1, p. 3).

Regarding Claim 52, Rathbone does not teach the underlined limitation - a method wherein:

- the configuration request further comprises a unique tag corresponding to the old computer system.

Jacobs discloses a method wherein:

Art Unit: 3628

- the configuration request (product search) further comprises a tag (product/model number) corresponding to the old (original) computer system. (see pp. 45 – 46, including pictures, especially Gateway website picture).

Russell discloses a method wherein:

- configuration items further comprises a unique tag (“unique identifier”) corresponding to the configuration item. (see p. 147).

Anonymous discloses a method:

- wherein the configuration request further comprises a unique tag (serial number) corresponding to the old (original) computer system. (“You will need to know the model of your computer, your serial number, and the manufacturer.”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone, Jacobs and Russell by incorporating a unique tag such as a serial number, as disclosed by Anonymous, to provide a unique identifier to the configuration request, rather than a generic identifier such as a product/model number, as disclosed by Jacobs, to properly and accurately link the configuration request to the user’s specific old computer system. Furthermore, the value of unique tags for configuration data is evident based upon the “unique identifiers” disclosed by Russell as a basic concept of configuration management.

Art Unit: 3628

Regarding Claim 53, Claim 53 recites similar limitations to Claims 44, 45 and 52, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 44, 45 and 52.

Regarding Claim 54, Claim 54 recites similar limitations to Claim 44 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 44.

Regarding Claim 55, Claim 55 recites similar limitations to Claims 46 and 47, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 46 and 47.

Regarding Claim 56, Claim 56 recites similar limitations to Claim 45 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 45.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rathbone, Jacobs, Russell and Anonymous, as with Claim 53 above, and in further view of Barzilai.

Claim 57 recites similar limitations to Claims 50 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 50.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection. However,

Art Unit: 3628

examiner will address an argument that the applicant is likely to believe still applies to the current rejection.

In response to applicant's argument that there is no suggestion to combine the references, the Courts have stated that “[a] suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references...The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art... there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (emphasis added). *In re Kahn*, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that he can and/or has provided such “articulated reasoning” to support the legal conclusion of obviousness.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The

Art Unit: 3628

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HYUNG SOUH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600